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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,356	06/25/2003	Thomas Daly		2566

7590

05/23/2005

Clifford Kraft
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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,356

Applicant(s)

DALY, THOMAS

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/25/2005 & 4/26/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-38 and 40-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/03, 12/3/03, 3/29/04, 7/19/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 36-45 are pending.

Election/Restrictions

1. Applicant's election with traverse of restriction/election and the election of carboxylic acid, esters and polyesters of Group XI in the reply filed on February 25, 2005 are acknowledged. The traversal is separately asserted on the ground(s) that:

(1) The Group VI and Group XI are classified in class 554. This is not found persuasive because said Groups are classified in different subclasses (i.e., areas of class 554).

(2) The polysiloxane compounds where silicon atoms are simply substituted for carbon atoms and the chemistry is the same (i.e., covalent bonding, etc.). This is not found persuasive because applicants have proffered no evidence that the chemistry of the compounds is the same, the silicon atom is not simply substituted for carbon, and the chemistry of hydrocarbons and polysiloxanes is known in the art to differ in properties and applications. The traversal does not address the fact that the polysiloxanes are separately classified and be expected to have separate utilities than a number of the other compounds included in the claims.

(3) Applicants further assert the compounds derive their antimicrobial properties from the bromo-nitro groups attached to a single carbon atom. Said properties appear with many different side groups R and R'. This is not found persuasive because the compounds are classified in different areas based on R and R' and the R and R' groups will affect the resulting uses, which the compounds have utility.

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Applicants' claim 36 has been interpreted as the single disclosed species elected. The compounds are interpreted as useful in metal working fluids as indicated by the presentation of claim 37. It is noted claims 37-39 are dependent on canceled claim 1.

2. Claim 39¹ has been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 25, 2005.

Claims 36-38 and 40-45 have been examined to the extent they read on the elected species.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. The USPG-PUB, 2002/0143139 A1, has been cited on the PTO-892 form.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36-38² and 43-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 37-39 are dependent on

¹ It is noted that claim 39 would be objected to as not further limiting since claim 36 does not provide for further bromine or nitro groups.

² It is noted that claim 39 would be objected to if they are amended to be dependent on claim 36. The structure of claim 36 does not provide for further bromine and nitro groups as required by claim 39. Contrast with claim 38, which not all compounds of claim 36 are surfactants set forth in 38.

canceled claim 1. It is unclear what applicants intend as the metes and bounds of said claims that is sought for patenting.

Claims 36 and 43-45 contain an improper alternative grouping. See MPEP § 2173.04(h). The claims are indefinite as to the scope of the members of the alternative group and the scope of the alternative group since the group is defined employing open language, i.e., "containing". See MPEP § 2111.03. The term "containing" is deemed synonymous to the open term "comprising".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 36-38 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Klemm et al, **Dünnschichtchromatographische Untersuchungen biocider 2-Brom-2-nitro-propan-Derivate**, *Journal of Chromatography*, Vol. 438, No. 1 (April 1, 1998) pages 122-125. Klemm et al (page 122, formula 2-15) discloses a generic structure for 2-bromo-2-nitro-propane-1,3-diol derivatives, wherein R and R' are defined in Table 1. Klemm et al (Table 1) defines R and R' to include fatty carboxylic acid residues including number 8 defining bis-stearate esters, i.e., $\text{H}_{35}\text{C}_{17}\text{C}(=\text{O})\text{OCH}_2\text{C}(\text{Br})(\text{NO}_2)\text{CH}_2\text{OC}(=\text{O})\text{C}_{17}\text{H}_{35}$. Claim 37 and 38 are included in this rejection since the compounds are inherently a metal working fluid base and a

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surfactant. The term "metal working fluid base" is interpreted as a basic material useful in metal working fluids.

8. Claims 36-38 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinto Fine KK, JP 2000053502 A, as evidenced by Derwent Abstract AN 2000-353243 and JPO machine translation. Shinto Fine KK (see Derwent Abstract) discloses industrial microbicide and microbistatic having use in industrial aqueous systems reading on the instant claim 34, wherein R1 and R2 are defined as alkyl groups. Claim 37 and 38 are included in this rejection since the compounds are inherently a metal working fluid base and a surfactant. The term "metal working fluid base" is interpreted as a basic material useful in metal working fluids.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinto Fine KK, JP 2000053502 A, as evidenced by Derwent Abstract AN 2000-353243 and JPO machine translation, optionally in view of Ajoku et al., US 5,656,670. Shinto Fine KK (see Derwent Abstract) discloses industrial microbicide and microbistatic having use in industrial aqueous systems reading on the instant claim 34, wherein R1 and R2 are defined as alkyl groups. The term "metal working fluid base" is interpreted as a basic material useful in metal working fluids.

To the extent claim 37 differs in the compounds are employed in a metal working fluid base, Shinto Fine KK (see Derwent Abstract) discloses industrial microbicide and microbistatic having use in industrial aqueous systems. Said industrial aqueous systems would include "metal working fluid base", such as soluble oils conventionally used as cutting oils, grinding or milling lubricants that conventionally employing biocides.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the Shinto Fine KK (see Derwent Abstract) industrial microbicide and microbistatic compounds in industrial aqueous systems including soluble oils conventionally used as microbicide and microbistatic agents in cutting oils, grinding or milling lubricants and conventionally employing biocides.

Ajoku et al (abstract and columns 1 and 2) discloses synergistic antimicrobial agents including 2-bromo-2nitropropane-1,3-diol related to the compounds of claim 36. Ajoku et al (column 1, lines 55 et seq) makes no distinction between "antimicrobial", "biocide", and "inhibiting microbial growth". Ajoku et al (column 1, lines 66 et seq) discloses a number of industrial fluids that the compositions may be added including paints, latex, cutting oils and metal working fluids for controlling bacterial growth and slime control.

These references are combinable because they teach biocides. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the compositions of Shinto Fine KK in a metal working fluid base as conventionally shown in the Ajoku et al reference.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 40-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-45 of copending Application No. 10/350,928. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims defining a reaction product of an alcohol and a carboxylic acid encompass the polymers of '928 copending claims.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM